



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/816,677

04/02/2004

Kinh-Luan (Lenny) Dao

03-302

9708

27774 7590 06/29/2010

MAYER & WILLIAMS PC
251 NORTH AVENUE WEST
2ND FLOOR
WESTFIELD, NJ 07090

EXAMINER

GHALI, ISIS A D

ART UNIT

PAPER NUMBER

1611

MAIL DATE

DELIVERY MODE

06/29/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<p align="center">Advisory Action Before the Filing of an Appeal Brief</p>	<p>Application No. 10/816,677</p>	<p>Applicant(s) DAO ET AL.</p>	
	<p>Examiner Isis A. Ghali</p>	<p>Art Unit 1611</p>	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 18 June 2010 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: _____.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). _____
13. ☐ Other: _____.

/Isis A Ghali/
Primary Examiner, Art Unit 1611

Continuation of 5. Applicant's reply has overcome the following rejection(s): the rejection of claim 17 and 18 under 35 U.S.C. 112, second paragraph, as being indefinite.

Continuation of 11. does NOT place the application in condition for allowance because: Claims 1, 5, 10, 11, 17-19, 23, 26, 31,32, 39-43, 46, and 47 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Harish et al. (WO 02/26162) combined with Pilliar (US 3,855,638).

Response to argument:

Applicants argue claim 1 requires a "medical article comprising: (a) an adhesive region comprising an adhesive; (b) a therapeutic agent, wherein at least a portion of said therapeutic agent is adhered to a surface of said adhesive region; and (c) microparticles, at least a portion of which are adhered to said surface of said adhesive region...". The adhesive region (i.e., prepolymer) taught by Harish and the therapeutic agents taught by Harish and Pilliar would be removed by the process of forming the porous coating that is taught by Pilliar. Specifically, the process taught by Pilliar involves heating slurry of metallic powder suspended in aqueous solution with organic binders to remove the water, followed by sintering in an inert or reducing atmosphere, such as hydrogen, to burn off the organic binder and fuse the particles together and to the substrate. Such a process would clearly remove the prepolymer adhesive region taught by Harish. Such a process would remove as well the therapeutic agents taught by Harish and Pilliar. Consequently, one would not be motivated to carry out such a process and one would not arrive to the presently claimed invention by employing such a process. One would not have been motivated to apply a therapeutic agent along with the metallic particles to an adhesive region in order to form an implantable device coated with dry powdered particles of therapeutic agents and metallic particles that are adhered together forming pores and adhered to the surface of the device.

In response to applicants' argument above, it is argued that Harish teaches therapeutic agents adhered to the surface of implantable devices as well as radio-isotopes and radiopaque substances, and further teaches biostables particles. Therefore, Harish suggested metallic particulates, however does not teach mixture of metallic particulates and therapeutic particulates as separate entities. Pilliar teaches metallic particulates and therapeutic agents. Pilliar is relied upon for teaching partial coating of implantable device with metallic particles to provide the implantable device with uniform strength. Further, one would have been motivated to apply therapeutic agent along with metallic particles because Pilliar teaches that pores formed by the metallic particles can be treated with therapeutic agents before implantation. One would reasonably expect formulating an implantable device coated with dry powdered particles of therapeutic agents and metallic particles that are adhered together forming pores and adhered to the surface of the device wherein the device has sufficient strength and controllably releases the particles of the therapeutic agents.

Further, applicants' attention is directed to the scope of the present claims that is directed to a product, and all the elements of the products are taught by the combined teachings of the prior art. The method of producing the products taught by the prior art do not impart patentability to the present claims. The fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985). In considering the disclosure of the reference, it is proper to take into account not only the specific teachings of the reference but also the inferences which one skilled in the art would reasonably be expected to draw therefrom. In *re Preda*, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968). The rational to modify or to combine the prior art does not have to be expressly stated in the prior art; the rational may be expressly or impliedly contained in the prior art or it may be reasoned from knowledge generally available to one of ordinary skill in the art. The reason or motivation to modify the reference may often suggest what the inventor has done, but for a different purpose or to solve different problem. It is not necessary that the prior art suggest the combination or modification to achieve the same advantage or result discovered by applicant. In *re Linter*, 458 F.2d 1013, 173 USPQ 560 (CCPA 1972). It has been held that "When a patent simply arranges old elements with each performing the same function it had been known to perform and yields no more than one would expect from such an arrangement, the combination is obvious." *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1740 (2007) (quoting *Sakraida v. AG Pro, Inc.*, 425 U.S. 273,282 (1976)). "When the question is whether a patent claiming the combination of elements of prior art is obvious," the relevant question is "whether the improvement is more than the predictable use of prior art elements according to their established functions." In addition, "To determine whether there was an apparent reason to combine the known elements in the way a patent claims, it will often be necessary to look to interrelated teachings of multiple patents; to the effects of demands known to the design community or present in the marketplace; and to the background knowledge possessed by a person having ordinary skill in the art. To facilitate review, this analysis should be made explicit. But it need not seek out precise teachings directed to the challenged claim's specific subject matter, for a court can consider the inferences and creative steps a person of ordinary skill in the art would employ". Pp. 11-14. *KSR INTERNATIONAL CO. v. TELEFLEX INC. ET AL.* (2007). A conclusion of obviousness under 35 U.S.C. 103 (a) does not require absolute predictability, only a reasonable expectation of success; and references are evaluated by what they suggest to one versed in the art, rather than by their specific disclosure. In *re Bozek*, 163 USPQ 545 (CCPA 1969). In the light of the foregoing discussion, the Examiner's ultimate legal conclusion is that the subject matter as a whole as defined by the claims would have been prima facie obvious within the meaning of 35 U.S.C. 103 (a).